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MAILED
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OFFICE OF PETITIONS

In re Application of :
Churchill, et al. : DECISION ON APPLICATIONS
Application No. 10/677,578 : FOR PATENT TERM ADJUSTMENT
Filed: October 2, 2003 : & NOTICE OF ABANDONMENT
Attorney Docket No. 115-007 :

This is a decision on the "Application for patent term adjustment under 37 CFR 1.705(b)" and the "Petition under 37 CFR 1.183," both filed September 17, 2010. In addition, this decision addresses the "Renewed application for patent term adjustment under 37 CFR 1.705(b)," filed October 29, 2010. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from thirty-three (33) days to one thousand two hundred forty-one (1241) days.

The petition under 37 CFR 1.705(b), filed September 17, 2010, is **dismissed** as untimely filed.

The petition under 37 CFR 1.183 to waive 37 CFR 1.705(b), filed September 17, 2010, is **dismissed**.

The petition under 37 CFR 1.705(b), filed October 29, 2010, is **dismissed**.

35 U.S.C. 154(b) provides for patent term adjustment for examination delay. Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 C.F.R. § 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall be given one opportunity to request reconsideration of that determination by way of filing of an application for patent term adjustment prior to the payment of the issue fee.

On June 3, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified

application. The Notice stated that the patent term adjustment (PTA) to date is 33 days. This determination was based in part on the period of adjustment entered for Office delay in mailing an Office action in response to an amendment filed October 10, 2006. PALM records indicate that the issue fee payment was received in the Office on August 19, 2010. No filing of an application for patent term adjustment preceded the payment of the issue fee. The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of mailing of the notice of allowance ended August 19, 2010. Accordingly, it is appropriate to dismiss the petition under 37 CFR 1.705(b) as untimely filed.

Petitioners request waiver of 37 CFR 1.705(b) under 37 CFR 1.183.

37 C.F.R. § 1.183 states,

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

In determining when waiver is appropriate, the Office *may* consider the circumstances when courts have exercised their equitable powers to waive requirements of a statute or regulation on behalf of a party. Courts are permitted to waive certain statutory requirements such as time limits.¹ Courts, in determining when waiver is proper, have required due diligence and required more than a "garden variety claim of excusable neglect."² The Federal Circuit has stated, "Equitable powers . . . should not be invoked to excuse the performance of a condition

¹ See Wood-Ivey Sys. Corp. v United States, 4 F.3d 961, 964 (Fed. Cir. 1993) (Plager, J., concurring) ("Since Irwin v. Department of Veterans Affairs, 498 U.S. 89, 112 L. Ed. 2d 435, 111 S. Ct. 453, (1990)], compliance with statutory time limits is no longer jurisdictional, in the old sense that when a Congressionally specified time limit had expired a court had no power to entertain the case. The presumption is now to the contrary. The court has jurisdiction to entertain the suit and to determine on the merits if equitable relief from the time bar is warranted.")

² See Wiggins v. State Farm Fire and Casualty Co., 153 F. Supp. 2d 16, 21 (D. D.C. 2001) ("A court can equitably toll the statute of limitations . . . plaintiff will not be allowed extra time to file unless he has exercised due diligence, and the plaintiff's excuse must be more than a 'garden variety claim of excusable neglect.'") (citations omitted).

by a party that has not acted with reasonable due care and diligence."³

Factors which may not justify tolling include: pro se status, illiteracy, deafness, lack of legal training, lack of knowledge of the law, lack of knowledge of a legal process, and lack of legal representation.⁴

An attorney's lack of knowledge, misinterpretation of a law, miscalculation of a time period, and failure to exercise due care and diligence will not justify waiver.⁵

An attorney failing to meet a clear deadline set in the rules of the Office is not an extraordinary situation and justice does not require waiver of the rules. The petition under 37 CFR 1.183 to waive 37 CFR 1.705(b) is **DISMISSED**.

³ U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983) (citations omitted) ("Lockheed had several means at its disposal which it could have employed to guarantee compliance with the regulation, yet it neglected to use any of them. Equitable powers . . . should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence."); See also Grymes v. Sanders et al., 93 U.S. 55, 61; 23 L. Ed. 798, 801 (1876) ("Mistake, to be available in equity, must not have arisen from negligence. . . . The party complaining must have exercised at least the degree of diligence 'which may be fairly expected from a reasonable person.'") (citing Kerr on Fraud and Mistake, 407); Garcia v. Office of Personnel Management, 2001 U.S. App. LEXIS 21616, 6 (Fed. Cir. 2001) ("Equity will not intervene, however, to protect a claimant from his or her own failure to exercise due diligence in preserving their legal rights.") (citing Irwin v. Department of Veterans Affairs, 498 U.S. 89, 95 (1990)); Goetz & Goetz v. Secretary of Health and Human Services, 2001 U.S. App. LEXIS 943, 5 (Fed. Cir. 2001) ("the special master's finding of a lack of due diligence was not arbitrary, capricious, or an abuse of discretion, and precludes the application of equitable tolling.") (citing Baldwin County Welcome Ctr. V. Brown, 466 U.S. 147, 151, 80 L. Ed. 2d 196, 104 S. Ct. 1723 (1984) which states, "One who fails to act diligently cannot invoke equitable principles to excuse their lack of diligence.")

⁴ See Felder v. Johnson, 204 F.3d 168 171-172 (5th Cir. 2000) (Pro se status is not "rare and exceptional" circumstance, but is typical of those bringing a 28 U.S.C. § 2254 claim. "Mere ignorance of the law or lack of knowledge of filing deadlines does not justify equitable tolling or other exceptions to a law's requirements.") (citing United States v. Flores, 981 F.2d 231, 236 (5th Cir. 1993) as "holding pro se status, illiteracy, deafness, and lack of legal training are not external factors excusing abuse of the writ."); citing Barrow v. New Orleans S.S. Ass'n, 932 F.2d 473, 478 (5th Cir. 1991) as "holding equitable tolling . . . within the Age Discrimination in Employment Act not warranted by plaintiff's unfamiliarity with legal process, his lack of representation, or his ignorance of his legal rights." (other citations omitted)).

⁵ See Harris v. Hutchinson, 209 F.3d 325, 330-331 (4th Cir. 2000) (Plaintiff argues that he relied on "negligent and erroneous advice" of his attorney. Attorney agrees his advice was erroneous. The court holds, "[A] mistake by a party's counsel in interpreting a statute of limitations does not present the extraordinary circumstance beyond the party's control where equity should step in to give the party the benefit of his erroneous understanding.") (citing Taliani v. Chrans, 189 F.3d 597, 598 (7th Cir. 1999) as "holding that a lawyer's miscalculation of a limitations period is not a valid basis for equitable tolling."; citing Sandvik v. United States, 177 F.3d 1269, 1272 (11th Cir. 1999) (per curiam) as "refusing to toll the limitations period where the prisoner's delay was assertedly the result of a lawyer's decision to mail the petition by ordinary mail rather than to use some form of expedited delivery."; citing Gilbert v. Secretary of Health and Human Services, 51 F.3d 254, 257 (Fed. Cir. 1995) as "holding that a lawyer's mistake is not a valid basis for equitable tolling."; other citations omitted.)

It is noted on September 20, 2010, applicants filed a petition to withdraw from issue along with a request for continued examination (RCE) and Information Disclosure Statement (IDS). By decision mailed September 20, 2010, the withdrawal from issue was granted. Prosecution was reopened.

A new Notice of Allowance was mailed on September 29, 2010 and applicants filed a second application for patent term adjustment under 37 CFR 1.705(b) on October 29, 2010.

Unfortunately, applicants did not timely respond to the September 29, 2010 Notice of Allowance and Fee(s) Due, which set a three month period for reply. This application became abandoned on December 30, 2010. No Notice of Abandonment has been mailed.

Applicants must file a petition under 37 CFR 1.137(b).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed;
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

Applicants must return a completed PTOL-85B or an equivalent, requesting reapplication of the previously paid issue fee as their reply. See Notice of Allowance and Fee(s) Due. How to Reply to This Notice: II. Part B - Fee(s) Transmittal.

In addition, the merits of the second petition under 37 CFR 1.705(b), filed October 29, 2010, will not be addressed until applicants pay the required \$200.00 petition fee.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

By internet: EFS-Web
 www.uspto.gov/ebs/efs_help.html
 (for help using EFS-Web call the
 Patent Electronic Business Center
 at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230.

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